



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,972	07/14/2005	Stephane Oberli	BLAN-37253	8739

116 7590 04/10/2008
PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

WATSON, ROBERT C

ART UNIT	PAPER NUMBER
----------	--------------

3723

MAIL DATE	DELIVERY MODE
-----------	---------------

04/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/516,972	Applicant(s) OBERLI ET AL.	
	Examiner Robert C. Watson	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 1-5, 7, and 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contain new matter. For example, claim 1 now recites "a radially resilient support part". However, there appears to be no support in the description that support part 13 is radially resilient. In fact, the description appears to recite the opposite at page 8, line 30 which recites "a rigid support part 13".

Claims 1-5, 7, and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase ",being radially bounded by the thin wall tubular part" is vague and indefinite since it is unclear which previously recited element is being described. Stated another way, the phrase has a dangling modifier. Further, it is unclear what "radially bounded by the thin wall tubular part" means.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcell in view of Workman.

Marcell shows a pig having a radially elastic relatively thin walled tubular part 20,21.

Workman shows a support part 18 mounted on a tubular part 10 with the support part and the tubular part supporting a V-shaped seal.

To provide on the radially elastic relatively thin walled tubular part of Marcell a support part and a V-shaped seal would have been obvious in view of the Workman disclosure. One skilled in the art would have been motivated to do this in order to achieve improved sealing. To make other portions of the pig resilient or rigid is no more than an obvious duplication of the teaching of the above applied references which already shows a flexible radially elastic thin walled tubular part 20,21 and other parts which are not so flexible.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcell in view of Workman supra and further in view of Jonnes.

Jonnes teaches that the support part may have teeth 16 extending radially.

To provide on the support part of Marcell teeth extending radially would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Jonnes. One of ordinary skill in the art would have been motivated to do this in order to enhance the ability of the support part to elastically deform and to reduce friction.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcell in view of Workman in view of Crane.

Whether component construction or integral construction is used is no more than an obvious matter of choice as these are both well known and obvious construction expedients. For example Crane shows that various parts comprised of elements 10, 10r, 10f may be integrally constructed. To apply this broad teaching of integral construction anywhere desired in Marcell would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Crane. Since the seal is disclosed as creating a vacuum with the walls of the pipe the seal may be termed a high pressure lip seal. The front guidance element 7, 10 is conical and has a receptacle. Such a receptacle, like all receptacles, capable of housing any number of structures including a cable ferrule.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcell in view of Workman and Crane and further in view of Shaer.

In Figure 2 of Schaer orifices 12 provide a pressure reducer in communication with an internal cavity 10 and the external space between the two seals 5.

To provide orifices between the seals of Marcell supra would have been obvious in view of the Shaer disclosure. One skilled in the art would have been motivated to do this to provide a pressure reducer if desired.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcell in view of Workman, Crane and Shaer supra and further in view of Constant et al.

Constant et al teaches that the front and rear parts of the pig may have conical guiding fingers. To provide conical guiding fingers on the front and rear parts of the

Marcell pig supra would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Constant et al. One of ordinary skill in the art would have been motivated to do this in order to better guide the pig through the pipe. In Schaer tubular part has an open front at 10 and a partially closed radial wall at 11.

Claim 6 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/10/07.

Applicant's remarks have been given careful consideration. Applicant argues that the combination of non-flexible and flexible parts is somehow novel. The above applied structure is found to be made of different materials – some resilient and some not so resilient. Hence the combination of non-flexible and flexible parts is found to be taught by the prior art. Moreover, the choosing which parts are flexible and which parts are resilient is no more than an obvious matter of design choice absent a showing of criticality for this combination. The claims are found to be an old combination of elements which, under the "KSR" doctrine, is not patentable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3723

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Watson whose telephone number is 571 272-4498. The examiner can normally be reached on Mon. - Thurs. , 5:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert C. Watson/

Primary Examiner, Art Unit 3723

Application/Control Number: 10/516,972
Art Unit: 3723

Page 7

rcw